

### ***REMARKS***

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-16 are now pending in this application. Claims 1, 8, 12 and 16 are independent.

Reconsideration of this application, as amended, is respectfully requested.

#### **Rejections under 35 USC 103(a)**

Claims 1-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable based upon various combinations of references, as addressed immediately below. These rejections are respectfully traversed.

Regarding claims 1-7, the Examiner admits that Jung et al. (U.S. Patent 6,441,401) lacks numerous structural features of the presently claimed invention. Next, the Examiner lists four references, which allegedly cure the deficiencies of Jung et al., namely "Ahn et al. (2001/0031910) further in view of Muto (4,902,638) further in view of Endo et al. (6,016,174) further in view of Kim et al. (6,429,909)."

For claims 8-11, the Examiner admits that Jung et al. lacks numerous method steps of the presently claimed invention. Next, the Examiner lists four references, which allegedly cure the deficiencies of Jung et al., namely "Kim et

al. (6,429,909) further in view of Muto (4,902,638) further in view of Endo et al. (6,016,174) further in view of Bae et al. (6,256,076).”

For claims 12-16, the Examiner admits that Jung et al. lacks numerous method steps of the presently claimed invention. Next, the Examiner lists four references, which allegedly cure the deficiencies of Jung et al., namely “Ahn et al. (2001/0031910) further in view of Muto (4,902,638) further in view of Endo et al. (6,016,174) further in view of Bae et al. (6,256,076).”

### **Analysis of the Rejections**

In each instance, the Examiner fails to provide any motivation to one of ordinary skill in the art to pick and choose structural features or method steps from these seven various references in order to arrive at the presently claimed invention. Such motivations must be found in the prior art of record or established common knowledge to those of ordinary skill in the art. The motivation to combine references cannot be based upon hindsight obtained from a reading of the present invention.

The Examiner has simply found seven references, which can be assembled in piecemeal fashion, five at a time, to resemble the presently claimed invention, and asserted that it would have been obvious to so assemble the many references “in order to have a liquid crystal display device with better performance.” This type of “bootstrapping” logic is counter to the requirements

that the Examiner must meet in order to make a *prima facie* showing of obviousness.

The courts have long recognized that almost all inventions are formed by a combination of previously known elements. If the Examiner's "bootstrapping" logic is allowed to serve as a motivation to combine references, then almost all inventions would be obvious. For example, if a new transmission includes a specific combination of different gears, all that would be needed to show the obviousness of the claimed transmission would be to find a number of documents, each describing a transmission having one of the claimed gears, and then assert that it would have been obvious to combine the references "in order to have a transmission with better performance."

This is simply not the state of the law. See *In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper). There is no cure-all phrase, like "in order to make a \_\_\_ with better performance," which satisfies the requirement of the Examiner to explain a motivation to combine the references. Rather, as stated in MPEP 2143.01, the motivation must be found either explicitly or implicitly in the references themselves, or in the knowledge generally available to one of ordinary skill in the art.

The rejections of record fail to show why one of ordinary skill in the art would have been motivated to remove the five specific structural elements or

method steps of Jung et al. Further, the rejections of record fail to state why one of ordinary skill in the art would have been motivated to replace the removed structural elements or method steps with five different structural elements or method steps selected from five other references. As such, it is respectfully submitted that these rejections fail to state a *prima facie* showing of obviousness and should be reconsidered and withdrawn.

### **CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mr. Scott L. Lowe (Reg. No. 41,458) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicant(s) respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and 1.17 for a one month extension of time in which to respond to the

Examiner's Office Action. The Extension of Time Fee in the amount of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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